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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

15436.212.1

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Signature _____

Typed or printed name _____

Application Number

10/782,565

Filed

2/19/2004

First Named Inventor

Weber

Art Unit

2633

Examiner

Bello

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)☒ attorney or agent of record.
Registration number 50,004☐ attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34 _____

Signature

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Typed or printed name

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2/24/06

Date

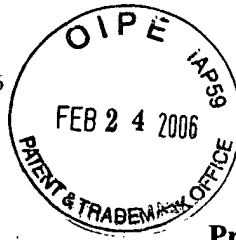
NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☐ *Total of 1 forms are submitted.

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Application No. 10/782,565
Pre-Appeal Brief Request for Review dated February 24, 2006
Reply to Final Office Action mailed August 24, 2005



**Pre-Appeal Brief Request for Review
Expedited Procedure
Examining Group 2633**

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PATENT APPLICATION
Docket No. 15436.212.1

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:)
)
	Andreas Weber)
)
Serial No.:	10/782,565) Art Unit
) 2633
Filed:	February 19, 2004)
)
For:	MODULE HAVING TWO BI-DIRECTIONAL)
	OPTICAL TRANSCEIVERS)
)
Confirmation No.:	5154)
)
Customer No.:	022913)
)
Examiner:	Agustin Bello)

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

A succinct, concise and focused set of arguments for which the panel review is being requested begins on page 2.

ARGUMENTS

Reconsideration of the application by a panel of examiners is respectfully requested in view of the following remarks. Please note that the following remarks are not intended to be an exhaustive enumeration of the distinctions between any cited references and the claimed invention. Rather, the distinctions identified and discussed below are presented solely by way of example to illustrate some of the clear errors and omissions in the rejections. In addition, Applicants request that the Panel carefully review any references discussed below to ensure that Applicants' understanding and discussion of the references, if any, is consistent with the Panel's understanding.

II. PRIOR ART REJECTIONS

A. Rejection Under 35 U.S.C. §102(b)

The Patent Office rejects claims 1-3, 5, and 7-8 under 35 U.S.C. § 102(b) as being anticipated by *Bhagavatula* (United States Patent No. 4,889,404). Because *Bhagavatula* does not teach or suggest each and every element of the rejected claims, Applicants respectfully traverse this rejection.

To anticipate a claim under 35 U.S.C. § 102(b) “[a] single reference must describe the claimed invention with sufficient precision and detail to establish that the subject matter existed in the prior art.” *Verve LLC v. Crane Cams Inc.*, 65 USPQ2d 1051, 1054 (Fed. Cir. 2002). “The identical invention must be shown in as complete detail as is contained in the ... claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236 (Fed. Cir. 1989); *see* MPEP 2131.

Bhagavatula teaches systems for bidirectional communication between a central station and a plurality of user stations. Col. 5, ll. 23-26. Moreover, *Bhagavatula* teaches that each connection between the central station and each of the distinct user stations is over a single optical fiber. Col. 5, ll. 23-38; Fig. 1. The central station is defined by *Bhagavatula* as: “The central station could be a telephone local exchange office or remote terminal, a cable television head end or a remote distribution station, a computer or a cluster of computers with associated controllers, a weapons control center or any other network or system site originating information for the system.” Col. 5, ll. 28-33. Notably, *Bhagavatula* does not disclose or suggest that the central station can itself be a single communications module in any form that anticipates the

elements set forth in Claim 1. *Bhagavatula* teaches in essence what is a central station that includes a plurality of bi-directional modules.

In direct contrast, claim 1 relates to a bidirectional communications module that communicates over dual cables. For an understanding of a module as the term is used in the present application, Applicant directs the Panel, for example, to modules 302, 304, and 400 in Figures 3-5 and the corresponding description of these modules. One cannot reasonably interpret the term "module" to encompass the "central station" in *Bhagavatula*. Applicants respectfully submit that there is a significant difference between *Bhagavatula*'s central location that can have any number of transceiver/receiver paired bi-directional modules, each of which communicates over a single fiber with a remote location, and a single module that is configured to communicate bidirectionally over dual cables. Accordingly, claim 1 specifically recites, inter alia: "wherein the first transmitter, the second transmitter, the first receiver, and the second receiver comprise a bi-directional communications module." As above noted, *Bhagavatula* does not teach such a communications module operable to communicate bi-directionally over two fibers, thus a *prima facie* rejection has not been made.

Claims 2-8 depend from claim 1 and include the limitations therein. Accordingly, claims 2-8 novel over *Bhagavatula* for at least the same reasons as claim 1. Since *Bhagavatula* does not teach the device being claimed in this application in as much detail as that set forth in claim 1, Applicants respectfully request that the rejection under 35 U.S.C. § 102(b) be withdrawn.

B. Rejections Under 35 U.S.C. § 103

The Patent Office rejects claims 9-12 under 35 U.S.C. § 103(a) as being unpatentable over *Bhagavatula* in view of *Hoag* (U.S. Pat. No. 5,712,936). Applicant respectfully traverse this rejection as based on clear error.

According to the applicable statute, a claimed invention is unpatentable for obviousness if the differences between it and the prior art "are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art." 35 U.S.C. § 103(a) (1994); *Graham v. John Deere Co.*, 383 U.S. 1, 14 (1966); MPEP 2142. Obviousness is a legal question based on underlying factual determinations including: (1) the scope and content of the prior art, including what that prior art teaches explicitly and inherently;

(2) the level of ordinary skill in the prior art; (3) the differences between the claimed invention and the prior art; and (4) objective evidence of nonobviousness. *Graham*, 383 U.S. at 17-18; *In re Dembiczak*, 175 F.3d 994, 998 (Fed. Cir. 1999). It is the initial burden of the PTO to demonstrate a prima facie case of obviousness, which requires the PTO to show that the relied upon references teach or suggest all of the limitations of the claims. MPEP 2142.

With regard to the rejections of claims 9 and 23 it is well established that the mere fact that something is “well-known” cannot serve as a substitute for motivation. *See In re Sponnovle*, 160 USPQ 237, 243 (CCPA 1969) (emphasis added) (“a patentable invention, within the ambit of 35 U.S.C. §103, may result even if the invention has, in effect, merely combined features, old in the art, for their known purpose, without producing anything beyond the results inherent in their use.”); *also see In re Warner*, 154 USPQ 173, 177 (CCPA 1967) which establishes that the question is never simply what is old; rather, the question is the obviousness of bringing the elements claimed in combination together. Accordingly, merely asserting that particular features of the claims are “old” or “well-known” in the art does nothing to establish a reason why the artisan would have been led to combine such features and, thus, does not inherently establish obviousness. Thus, the rejection of claims 9 and 23 is improper for lack of motivation for the claimed combination of elements.

Moreover, It is well recognized that in order to have a valid case of prima facie obviousness, all claim limitations must be taught or suggested (see MPEP §2143). Because the rejection relies upon the same description of *Bhagavatula* with regard to anticipation (which does not address various elements such as the term “module” or “dual fiber” elements as discussed above) the rejection under 35 U.S.C. 103(a) is improper because each element of claims 9 and 23 has not been addressed.

Claims 10-12 depend from claim 9. If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988). Accordingly, claims 10-12 are patentable over *Bhagavatula* for at least the same reasons as claim 9.

Regarding the rejection of claims 13-22, Applicants traverse the Examiner’s rejection for obviousness on the grounds that *Bhagavatula* fails to teach or suggest each and every element of the rejected claims. As previously noted, *Bhagavatula* teaches a central station that is not the

same as the module claimed. Rather, *Bhagavatula* teaches in essence what is a central station that includes a plurality of bi-directional modules. Each bi-directional module at the central station is in communication over a single fiber with one of a plurality of user stations. See Figure 1. Rather, in direct contrast, present claim 13 recites, inter alia: "a first bi-directional communications module, comprising a first bi-directional transceiver . . . and a second bi-directional transceiver" and "a second bi-directional communications module, comprising a third bi-directional transceiver . . . and a fourth bi-directional transceiver." The Applicant therefore respectfully asserts that the Office Action fails to set forth a prima facie case of obviousness.


With reference to claims 15 and 18, *Bhagavatula* fails to teach or suggest methods using first and second optical modules as presently claimed. By way of example of the various distinctions between claims 15 and 18 and *Bhagavatula*, *Bhagavatula* does not teach the use of first and second optical fibers to interconnect a first optical module (or bi-directional communications module) with a second optical module (or bi-directional communications module). Rather, *Bhagavatula* uses single optical fibers (e.g. fiber 14-1) to interconnect optical modules. Claims 14, 16, 17, and 19-22 depend from claim 13, 15, or 18 and include the limitations therein. Accordingly, claims 14, 16, 17, and 19-22 are patentable over *Bhagavatula* for at least the same reasons as claims 13, 15, or 18.

CONCLUSION

In view of the foregoing, Applicants believe the claims as amended are in allowable form. In the event that the Examiner finds remaining impediment to a prompt allowance of this application that may be clarified through a telephone interview, or which may be overcome by an Examiner's Amendment, the Examiner is requested to contact the undersigned attorney.

Dated this 24 day of February, 2006.

Respectfully submitted,



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